UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,877	12/05/2001	Hiroshi Niwa	986.701	8538

26129 7590 04/22/2004

CHAN LAW GROUP LC
1055 W. 7TH ST,
SUITE 1880
LOS ANGELES, CA 90017

EXAMINER	
GRAY, JILL M	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/002,877	NIWA, HIROSHI	
	Examiner	Art Unit	
	Jill M. Gray	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,13-22,24,25 and 27-35* is/are pending in the application.

4a) Of the above claim(s) *11,13-17 and 25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,18-22,24 and 27-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/31/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I in Paper No. 02/02/03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Response to Amendment

The rejection of claims 1, 3, 5-7, 9-16, 18, 20, and 22-34 under 35 U.S.C 103(a) as being unpatentable over Fontana 6,123,982 is withdrawn in view of applicants' amendments.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, the specification as originally filed, is completely devoid of any specific amounts of aloe vera in the softening solution. There is no disclosure, either explicit or inferred of aloe vera in an amount of 0.026% by volume.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 and 30-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, claim 18 is indefinite because the language "textile fibers" lacks the proper antecedent basis.

Claims 30-34 are indefinite because they have inconsistent preamble language and lack the proper antecedent basis. Also, these claims appear to be incomplete.

Claim Rejections - 35 USC § 102

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 4, 8, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Fontana 6,123,982, for reasons of record.

Fontana teaches yarn impregnated with an aloe vera solution. The present claims are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentablility is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process". *In re Thorpe,* 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Therefore, the teachings of Fontana anticipate the invention as claimed in present claims 2, 4, 8, 19, and 21.

Claims 1-8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Warner et al, 5,716,692 (Warner).

Warner teaches lotioned tissue paper comprising textile fibers treated with a softening solution containing aloe vera, per claims 2, 4, 7, and 8, and a method comprising forming a solution including aloe vera, infusing textile fibers with said solution and drying. See column 8, lines 52-55 and Examples. In addition, Warner, in Figure 1, teaches a method comprising forming a solution including aloe vera, providing a reservoir of said solution, conducting said solution from said reservoir to the outer surface of a roller, (claims 3 and 5) wherein the amount of solution on said outer surface is controlled using doctor blades, (claim 6), further teaching an additional roller in parallel to said roller having an outer surface (claim 7) and conveying the textile fibers to a storage container after contact with the rollers (claim 10). See Figure 1 and column 17, line 35 through column 18, and line 20.

Therefore, the teachings of Warner anticipate the invention as claimed in claims 1-8 and 10.

Claims 18-19, 21, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT Publication WO 99/19081 (Nielsen).

Nielsen teaches textile products coated with a solution containing softening agent and aloe extract, per claims 19, 21, and 35 and a method of treating yarn comprising the steps of forming a solution containing softener and aloe, infusing the yarn with said

solution and drying said yarn, per claim 18. See pages 19, 22 and 23. Regarding claims 19, 21 and 35, these claims are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentablility is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process". *In re Thorpe,* 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Therefore, the teachings of Nielsen anticipate the invention as claimed in present claims 18-19, 21 and 35.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 20, 22, 24, and 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication WO 99/19081 (Nielsen) as applied above to claims 18-19, 21 and 35 in view of Warner et al, 5,716,692 (Warner), as applied above to claims 1-8 and 10.

Nielsen is as applied above and additionally teaches that his composition can be applied to the textile products using other application methods such as applying the composition to a transfer surface such as a roll or roller, wherein the composition is

ultimately transferred to the textile product (see page 38) although not specifically teaching the method of claims 20, 22, 24, and 28. It would have been obvious to the skilled artisan at the time the invention was made, to modify the teachings of Nielsen by using a method as taught by Warner and applicants to apply his composition to the textile products and yarns with the reasonable expectation of obtaining yarns having a solution containing aloe applied thereto. Regarding claims 29-31, Nielsen teaches that the textile fibers used in his textile products can be acrylic, wool or cotton, as required by applicants. See page 19. As to claims 32-34, the formation of twisted yarns is well known in the art and would have been an obvious expedient to the skilled artisan at the time of the invention thereof.

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 5-7, 9-16, 18, 20, and 22-34 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed February 2, 2004 have been fully considered but they are not persuasive.

Applicants argue that Fontana neither teaches nor suggests using aloe vera to change the character of the textile fiber or yarn, further arguing that Fontana does not teach, suggest or disclose the effect of inclusion of aloe vera in the water-soluble polymer on the binding of the yarn in the tension stretched condition.

As set forth previously, claims 2, 4, 8, 19, and 21 are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentablility is based on the product itself. The patentability of a

product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process". *In re Thorpe,* 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant case, the prior art product of Fontana is the same, namely, a textile fiber or yarn coated with a solution containing aloe vera and therefore is unpatentable over the prior art. Furthermore, the prior art is not necessarily required to teach the same purpose as applicants.

No claims are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jill M. Gray
Examiner
Art Unit 1774

jmg

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700